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Bottorff

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Antisense Pharma GmbH

Serial No. 76036465

Julie B. Seyler of Abelman Frayne & Schwab for Antisense Pharma GmbH.

Yong Oh (Richard) Kim, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Seeherman, Quinn and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Supplemental Register of the mark ANTISENSE PHARMA (in typed form), for goods identified in the application (as amended) as "pharmaceutical preparations for the treatment of vascular, inflammatory, neoplasm, degenerative, infectious, congenital, autoimmune, traumatic, and endocrine diseases and disorders; veterinary preparations for the treatment of vascular, inflammatory, neoplasm, degenerative, infectious,

congenital, autoimmune, traumatic, and endocrine diseases and disorders in bovines, sheep, horses, cats and dogs," in Class 5.¹

At issue in this appeal is the Trademark Examining Attorney's final refusal to register the mark on the Supplemental Register, on the ground that it is incapable of distinguishing applicant's goods. See Trademark Act Sections 23 and 45, 15 U.S.C. §§1091 and 1127. The appeal is fully briefed, but no oral hearing was requested. We reverse the refusal to register.

In cases involving refusals to register on the Supplemental Register, the issue is not whether the matter sought to be registered presently functions as a mark, but rather whether the matter is capable of functioning as a mark at some time in the future upon a showing of acquired distinctiveness. See, e.g., *In re Minnesota Mining & Mfg.*

¹ Serial No. 76036465, filed April 27, 2000. The application is based on applicant's ownership of a German registration, No. 399 67 788, pursuant to Trademark Act Section 44(e), 15 U.S.C. §1126(e). Applicant originally sought registration of the mark on the Principal Register. In response to the Trademark Examining Attorney's refusal to register under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), applicant amended the application on June 21, 2001 to one seeking registration on the Supplemental Register. In response to the Trademark Examining Attorney's requirement, applicant submitted the following translation statement: "In the German language, PHARMA is a prefix for words such as "pharmkologi" (pharmacology); "pharmazeut" (apothecary); "pharmazeutisch" (pharmaceutical) and "pharmazie" (pharmacy). However, in and of itself, PHARMA is not a German word and there is no 'clear and exact equivalent' in English. TMEP 809.02."

Co., 335 F.2d 836, 142 USPQ 366 (CCPA 1964); *In re School Book Fairs, Inc.*, 229 USPQ 556 (TTAB 1986). In the present case, the Trademark Examining Attorney contends, under two alternative theories, that ANTISENSE PHARMA is incapable of distinguishing applicant's goods. First, he contends that the designation is the generic name for applicant's goods, because ANTISENSE is a generic name for a class of drugs and PHARMA is a common abbreviation for "pharmaceuticals," the goods at issue here. In the alternative, he contends (again) that ANTISENSE is generic for a class of drugs, and that PHARMA is incapable of distinguishing applicant's goods because it is merely an entity designation denoting a company that makes and sells pharmaceuticals. According to the Trademark Examining Attorney,

regardless of whether PHARMA is perceived as an abbreviation for "pharmaceutical" or as an entity designation, it is incapable of functioning as an indicator of source. Furthermore, combining two incapable terms, i.e., ANTISENSE and PHARMA, fails to result in a phrase that is anything more than the sum of its parts.

(Brief, at unnumbered page 6.) We are not persuaded by either of the Trademark Examining Attorney's arguments.

We agree with the Trademark Examining Attorney's contention that ANTISENSE is a generic term as applied to

applicant's goods, and that it therefore is incapable of distinguishing applicant's goods. The Trademark Examining Attorney has made of record the following definition of "antisense" (dated December 12, 1998) from On-Line Medical Dictionary (www.graylab.ac.uk/cgi-bin/omd?antisense):

In general the complementary strand of a coding sequence of DNA (**antisense** DNA) or of mRNA (antisense RNA). A collection of nucleotide sequences which are not templates for synthesis but yet interact with complementary sequences in other molecules thereby causing function of those molecules to be affected. **Antisense** RNA hybridises with and inactivates mRNA.
[Emphasis added.]

Also of record is the following definition of "antisense therapy" from Segen, Current Med Talk A Dictionary of Medical Terms, Slang & Jargon (1995) at p. 47:

An as-yet hypothetical therapeutic modality for treating tumors and viral disease that would be based on **antisense** RNA, where complementary strands of nucleotides are used to turn off defective genes...; **antisense** therapy would consist of administering an **antisense** DNA or an RNA strand mirror-image of an oncogene's mRNA 'sense' strand... [Emphasis added.]

On applicant's own website (a printout of which was made of record by the Trademark Examining Attorney as an attachment to the June 27, 2002 Office action), applicant repeatedly

uses the term "antisense" generically to refer to its goods. For example [emphasis added]:

Antisense drugs are a new generation of therapeutic agents offering a causal approach to treating diseases currently regarded as incurable.

. . . .

Antisense drugs are able to block the blueprint of a protein and specifically prevent its conversion into the pathogenic protein which, for example, causes uncontrolled tumour growth. In complete contrast to gene therapy, **antisense drug** treatment does not interfere with the genetic information, i.e., no genes are changed.

The first **antisense drug** was approved in the USA in 1998 by the American Food and Drug Administration (FDA).

. . . .

The **antisense agents** developed by ANTISENSE PHARMA can selectively prevent the formation of proteins... This causal approach makes **antisense therapy** an innovative therapeutic modality...

ANTISENSE PHARMA holds the exclusive rights to worldwide licences for antitumoural therapeutics that use specific **antisense oligonucleotides**. Our leading **antisense product** A12009, designed to activate the body's own immune system against malignant tumours, is currently in the clinical trial phase. A solid international patent portfolio includes other candidate **antisense compounds** as well as various target proteins.

The Trademark Examining Attorney also has made of record printouts from the websites of applicant's apparent competitors Hybridon, Cureon, and Isis Pharmaceuticals, which likewise demonstrate generic use of "antisense" in connection with the goods at issue here. See, for example, the following from Hybridon (www.hybridon.com/antisense) [emphasis added]:

Antisense technology is a drug-discovery platform that involves design and use of synthetic oligonucleotides to inhibit production of specific proteins.

. . .

To block production of the undesirable protein, an **antisense drug** is designed with a sequence complimentary [sic] to the target mRNA. The **antisense drug** is a mirror image (**antisense**) to a portion of the mRNA (sense).

See also the following from Cureon A/S

(www.cureon.com/about_cureon/companyprofile) [emphasis added]:

The company believes that the unique properties of this novel analogue will enable oligonucleotide based therapeutics (**antisense therapy**) to enter main-stream pharmaceuticals. LNA is a group of novel DNA analogues that possesses a range of unique biochemical and biological properties that top the wish list for **antisense compounds**. ... These and a suite of other attractive features are rapidly establishing LNA as a prominent player in gene

target validation as a chemistry of choice in **antisense therapy**. ... Cureon aims at becoming the leading **antisense drug** discovery company through its proprietary position on LNA...

Finally, see the following from Isis Pharmaceuticals
(www.isip.com/press/press02/061802-LillyCollabExpanse)
[emphasis added]:

Isis and Lilly will collaborate to discover **antisense drugs** to inhibit specific gene targets associated with cancer. The expanded collaboration will focus initially on several **antisense preclinical compounds**, ... The cancer collaboration builds on the broad, strategic alliance the companies forged in August 2001, to among other things, discover **antisense drugs** in the areas of inflammatory and metabolic diseases.

Based on this evidence, we find that ANTISENSE is a generic term as applied to the pharmaceutical products identified in applicant's application. The genus of goods at issue is "antisense drugs," of the type referred to in the above-quoted evidence; such drugs must be presumed to be encompassed within the "pharmaceutical preparations" broadly identified in applicant's identification of goods. The evidence shows that the relevant purchasing public primarily understands "antisense" to refer to this category or genus of drugs. See *H. Marvin Ginn Corp. v.*

International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Because ANTISENSE is generic as applied to applicant's goods, it is incapable of distinguishing applicant's goods. Applicant's mark is not registrable on the Supplemental Register without a disclaimer of ANTISENSE apart from the mark as shown.²

However, the evidence of record fails to establish that applicant's mark in its entirety, i.e., the phrase ANTISENSE PHARMA, is generic for applicant's goods. Because ANTISENSE PHARMA is a phrase rather than a compound term, evidence showing generic use of the phrase as a whole is necessary to support a genericness finding. See *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). Even if we were to accept the Trademark Examining Attorney's contention that the word PHARMA is a generic abbreviation for the generic word "pharmaceuticals,"³ there is no evidence which shows that

² See discussion *infra* regarding this disclaimer requirement.

³ In fact, we are not persuaded that the Trademark Examining Attorney has established, with the requisite clear evidence, that PHARMA is an accepted abbreviation of the word "pharmaceutical" and that it therefore is a generic term as applied to applicant's goods. The Trademark Examining Attorney has submitted a printout from an online acronym/abbreviation dictionary (www.pharmallexicon.com) which identifies "pharma" as an abbreviation of "pharmaceutical" or "pharmacy." However, applicant has submitted (with its appeal brief), and has requested that we take judicial

the entire phrase at issue, ANTISENSE PHARMA, is used as a generic term. Therefore, we reject the Trademark Examining Attorney's contention that the mark is incapable of

notice of, excerpts from Webster's Third New International Dictionary (Unabridged), Stedman's Medical Dictionary (4th Unabridged Lawyers' Edition), and the PDR Medical Dictionary (1st ed.), none of which has any entry for "pharma." The Board may take judicial notice of dictionary definitions. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). The Board also has conducted its own review of numerous medical and healthcare dictionaries, i.e., Jablonski, Dictionary of Medical Acronyms & Abbreviations (4th ed. 2001); Borland's Illustrated Medical Dictionary (29th ed. 2000); Miller-Keane Encyclopedia & Dictionary of Medicine, Nursing & Allied Health (6th ed. 1997); Mosby's Medical Dictionary (4th ed. 1994); Stedman's Medical Dictionary (27th ed. 2000); Segen, Current Medical Terms, Slang & Jargon (1995); Mosby's Medical, Nursing & Allied Health Dictionary (5th ed. 1998); Current Medical Terminology (1998); Barron's Dictionary of Medical Terms (2000); Taber's Cyclopedic Medical Dictionary (1997); Lexicon Dictionary of Health Care Terms, Organizations & Acronyms (2d ed. 1998); and Pharmacy Simplified A Glossary of Terms (2001). In none of these reference works is there any entry or definition for "pharma," either as a word or as an abbreviation (for "pharmaceutical" or for anything else). Indeed, the majority of these dictionaries identify "phar" or "pharm," not "pharma," as the accepted abbreviation for "pharmaceutical." The Trademark Examining Attorney also has submitted printouts from various websites showing use of "pharma." However, we cannot determine the source of several of the websites (because the URL is not shown), and several of the others appear to be foreign in origin. In any event, none of the websites demonstrates clearly generic use of "pharma." Finally, the Trademark Examining Attorney has submitted printouts of five third-party registrations and applications in which the term PHARMA has been disclaimed. However, these marks are registered (or are sought to be registered) on the Principal Register; the disclaimers of PHARMA may have been required on the basis of the term's mere descriptiveness, not necessarily on the ground of genericness. Moreover, applicant has made of record eighteen third-party registrations of marks which include the term PHARMA, all of which are on the Principal Register and none of which includes a disclaimer of PHARMA. Thus, the evidence shows, at most, that the term is merely descriptive; we cannot conclude that it is incapable of distinguishing applicant's goods.

distinguishing applicant's goods (and therefore unregistrable on the Supplemental Register) because it is generic.

The Trademark Examining Attorney's alternative theory is that ANTISENSE PHARMA is incapable of distinguishing applicant's goods because it merely combines the generic term ANTISENSE with what the Trademark Examining Attorney deems to be a mere entity designation, i.e., PHARMA. See, e.g., *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213 (TTAB 2000); and *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988). We find that the evidence of record fails to support this argument either.

The Trademark Examining Attorney has submitted a printout from an online dictionary called hyperdictionary (www.hyperdictionary.com/dictionary/pharma) in which "pharma" is defined as "a company that makes and sells pharmaceuticals." This is some evidence in support of the Trademark Examining Attorney's position, but we find that it is outweighed by the fact that this online dictionary appears to be the only dictionary which includes this definition of "pharma." As noted above (see *supra* at footnote 3), the Board has reviewed numerous medical and healthcare dictionaries, and in none of them is there an entry for the term "pharma." The Trademark Examining

Attorney also has submitted evidence showing that numerous pharmaceutical companies use the word PHARMA in their names.⁴ However, we cannot conclude from the mere fact that the term appears in these companies' names that it is an entity designation. It is just as likely that the term is being used in a descriptive sense, and would be understood as such. Mere descriptiveness does not preclude registration on the Supplemental Register. In the absence of more concrete dictionary or similar evidence which clearly shows that PHARMA, to the industry and to the relevant class of purchasers, is an accepted and commonly-used entity designation, we cannot conclude that companies which use the term in their names intend it to be merely an entity designation, or that purchasers would understand it as such.

For the reasons discussed above, we find that applicant's mark ANTISENSE PHARMA, viewed as a whole, is capable of distinguishing applicant's goods, and that it therefore is registrable on the Supplemental Register. However, the mark is not registrable (even on the

⁴ These include Roche Pharma (Schweiz) AG, BioChem Pharma, Aventis Pharma, Purdue Pharma LP, Jones Pharma Incorporated, Schwarz Pharma, Chugai Pharma Europe Ltd., Axcan Pharma Inc., MDS Pharma Services, UCB Pharma, and LEO Pharma.

Supplemental Register) without a disclaimer of the generic word ANTISENSE apart from the mark as shown.

Decision: In the absence of a disclaimer of ANTISENSE, the refusal to register the mark on the Supplemental Register is affirmed. However, this decision will be set aside if, within thirty days of the date of this decision, applicant submits (to the Board) a disclaimer of the word ANTISENSE apart from the mark as shown.